

### REMARKS

Reconsideration of this application is respectfully requested in view of the foregoing amendment and the following remarks.

Applicant has amended the specification and claims to address the informalities noted by the Examiner. "E-caprolactone" is intended to mean "epsilon-caprolactone," which as noted by the Examiner, is the only reasonable interpretation of this expression. As shown by the attached web pages, the term "e-caprolactone" is often used as abbreviation for and interchangeably with the term "epsilon-caprolactone." Nevertheless, the specification has been amended for clarity.

Claims 1-20 have been rejected under 35 U.S.C. § 103 as unpatentable over Slagel, U.S. Patent No. 6,127,505 (the '505 patent). Applicant respectfully traverses this rejection. The claims of the present application are directed to a polyurethane material made from a prepolymer containing a triol in an amount equal to 0.06 to 0.15 equivalents based upon a total of 1.0 equivalents of OH-containing intermediates. Applicant agrees with the Examiner that, if 4 weight percent trimethylol propane were added to Example V of the '505 patent, this would result in a level *somewhat less* than 0.5 equivalents based on total equivalents of the claimed materials (i) and (ii). This does *not* however, mean that the disclosure of the '505 patent falls within the metes and bounds of the claimed invention. On the contrary, 4 weight percent is the *minimum* amount of triol disclosed in the '505 patent, and 0.5 equivalents is the *maximum* amount claimed in the present application. Accordingly, there is no overlap between the claimed range and that disclosed in the '505 patent.

Moreover, reducing the amount of triol to the level claimed in the present application has produced a surprising and unexpected result. In particular, the polyurethane materials containing a triol in an amount equal to 0.06 to 0.15 equivalents, as claimed in the present application, are less brittle than materials containing a triol an amount of 4 to 8% by weight based on total reactants, as disclosed in the '505 patent. (*See* cols. 5-6.) For example, whereas a polyurethane containing 1.22 weight percent trimethylol propane (corresponding to 0.15 equivalents in this example) is somewhat brittle, a polyurethane containing 4.27 weight percent trimethylol propone would be extremely brittle. *See* Declaration of Bob Fogarty, attached hereto. There is no disclosure or suggestion in the '505 patent to modify the amount of trimethylol propane, or that improved properties could be obtained by addition of a lower amount of trimethylol propane. Therefore, based upon the disclosure of the '505 patent, it would not have been obvious to one of ordinary skill in the art to produce polyurethanes having the level of triols described in pending claims.

In view of the foregoing all of the claims in this case are believed to be in condition for allowance. Should the Examiner have any questions or determine that any further action is

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desirable to place this application in even better condition for issue, the Examiner is encouraged to telephone applicants' undersigned representative at the number listed below.

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Respectfully submitted,

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Date: August 13, 2003

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Attachment: Declaration of Bob Fogarty

Web pages: <http://web.utk.edu/~atlas/databank/ester/pcl/pcl.html> (page 1 of 1)  
<http://web.utk.edu/~atlas/databank/ester/pcl/pclcalcr.html> (pages 5 of 5)

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